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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/699,901

11/03/2003

Martin Novil

03-0019/CPA

4385

29293

7590

10/31/2006

FREUDENBERG-NOK GENERAL PARTNERSHIP
LEGAL DEPARTMENT
47690 EAST ANCHOR COURT
PLYMOUTH, MI 48170-2455

EXAMINER

PICKARD, ALISON K

ART UNIT

PAPER NUMBER

3673

DATE MAILED: 10/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/699,901

Applicant(s)

NOVIL ET AL.

Examiner

Alison K. Pickard

Art Unit

3673

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 and 36-62 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-30 and 62 is/are allowed.
- 6) ☒ Claim(s) 31-34, 36-56 and 58-61 is/are rejected.
- 7) ☒ Claim(s) 57 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application
- ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 31-34, 36-56, 58-60, and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nicholson (6,131,915).

Nicholson discloses a gasket assembly comprising at least one rigid carrier 6 (or 8) and a planar shim 10 or see col. 5, line 44. The carrier and shim have a gasket opening 4. The carrier has an inner flexible sealing portion 14 adjacent to and defining the opening. The inner sealing portion is longitudinally offset relative to the carrier. The carrier has a flexible stopper portion 12, 110a or 110c that limits the amount of compression of the inner portion and is less flexible than the inner portion (see 4:58-67, 5:19-24; and 5:1-5, which says shape can be changed to V or arcuate to create some flexibility but still limit compression). The inner seal is offset greater than the stopper portion (see Figs. 6-10). The stopper is spaced from the opening but is still in close proximity to the inner portion and around the same opening (see Fig. 12). Rubber coatings can be applied various surfaces of the gasket (5:58-63). Regarding claim 47, screen-printing is a process step in a product claim and is give little patentable weight. Regarding claims 48-55, these claims are considered intended use. The gasket is capable of being used in these environments. Nicholson does not disclose the stopper is trapezoidal. Making the shape trapezoidal is considered obvious. See *In re Dailey* 149 USPQ 47 (CCPA 1966). Therefore, it

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would have been obvious for one of ordinary skill in the art at the time the invention was made to make the stopper trapezoidal in shape.

Allowable Subject Matter

3. Claim 57 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

4. Claims 1-30 and 62 are allowed.

Response to Arguments

5. Applicant's arguments filed 8-18-06 have been fully considered but they are not persuasive.

The examiner maintains that the stopper portions (any of 12, 110a, or 110c) are flexible. Nicholson discloses the entire gasket is "flexible" and only indicates the perpendicular struts are strong. This does not imply that they aren't flexible. And, Nicholson does NOT teach away from using other shapes. In fact, Nicholson clearly states other profiles can be used. Again, Diez and Yamada provide evidence that trapezoidal, rectangular, and arcuate shapes are art equivalent shapes of flexible beads. And, the gasket can be made of stainless steel, which has good spring qualities. Thus, a stainless steel bead would have some degree of flexibility.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alison K. Pickard whose telephone number is 571-272-7062. The examiner can normally be reached on M-F (10-7:30), with alternate Friday's off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tricia Engle can be reached on 571-272-6660. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Alison K. Pickard
Primary Examiner
Art Unit 3673

